

REMARKS

The Office Action mailed January 29, 2003 has been reviewed and carefully considered. Claims 1-17 are pending in this case, claims 1, 3, 7, 12 and 15 being the independent claims. Claim 12 has been amended to correct typographical errors. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1-2, 7-8, 12 and 14 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over U.S. Patent No. 6,148,197 to Bridges et al. ("Bridges") in view of U.S. Patent No. 6,456,839 to Chow et al. ("Chow").

The invention as recited in claim 1 is directed to a home-zone location registering method that includes the steps of "determining, by the portable radio telephone, whether the portable radio telephone deviates from the home zone; and, informing, by the portable radio telephone, to a mobile switching center if the portable radio telephone is deviated from the home zone."

The Bridges reference fails to disclose or suggest at least the limitation of "informing, by the portable radio telephone, to a mobile switching center if the portable radio telephone is deviated from the home zone" which is explicitly required by the language of claim 1.

The Office Action suggests that the informing step is found in some

combination of FIG. 4, ref. no. 106; col. 12, lines 20-50; col. 17, line 58 to col. 18, line 11, and the examiner's explanatory comment that "routing information" amounts to "informing."

Reference number 6 in FIG. 4 annotates a conventional message switching center, but fails to disclose or suggest "informing, by the portable radio telephone, to a mobile switching center if the portable radio telephone is deviated from the home zone."

Lines 20-50 in column 12 discuss a mobile station determining whether it is located in its home system. If it is located in the home system, the mobile station determines that it will utilize the home wireless carrier, i.e. service provider. If, on the other hand, the mobile station is outside its home system, the mobile station queries if its current carrier is preferred. If so, the mobile station uses its current carrier. If not, the mobile station consults a list of preferred carriers to select a carrier. In this carrier determination process, there is no suggestion or hint of the mobile station communicating with a mobile switching center. Column 12 fails to disclose or suggest "informing, by the portable radio telephone, to a mobile switching center if the portable radio telephone is deviated from the home zone."

Starting on line 58 of column 17 and ending on line 11 of column 18, Bridges discloses downloading preferred list information to a mobile station when the information is updated. There is no disclosure or suggestion of uploading to a mobile

switching center or anywhere else and no suggestion of action being taken if there is deviation from the home zone. This passage too fails to disclose or suggest “informing, by the portable radio telephone, to a mobile switching center if the portable radio telephone is deviated from the home zone.”

Chow relates to billing for mobile services, but cannot make up for the deficiencies in Bridges. Accordingly, claim 1 is believed to be patentable over Bridges in view of Chow for at least the above-stated reasons. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 7 recites a “home-zone location registering apparatus . . . comprising:

a memory for storing a home-zone list;

a receiving section for receiving a predetermined signal from a base transceiver station (BTS);

a comparing section for checking whether the portable radio telephone deviates from the home zone by comparing the predetermined signal from the BTS with the home-zone list stored in memory; . . .”

The Bridges mobile station determines if it is in its home system by comparing a SID or SOC received on the control channel with the home SID or SOC in the mobile station’s number assignment module (NAM) (col. 3, lines 4-8; col. 12, lines

20-28). Earlier in item 2, in rejecting claim 1, the Office Action suggested that the home-zone list of claim 1 corresponds to the “updated list of carrier identities” in Bridges (col. 7, line 53). There is no disclosure or suggestion in Bridges that the updated list of carriers is compared to a predetermined signal to determine the mobile station’s relative location. Accordingly, Bridges fails to disclose or suggest, at the very least, “a comparing section for checking whether the portable radio telephone deviates from the home zone by comparing the predetermined signal from the BTS with the home-zone list stored in memory.”

Item 2 of the Office Action acknowledges that “modified Bridges” fails to disclose the comparing section. Presumably, “modified Bridges” refers to the Bridges/Chow combination proposed in rejection of claim 1.

In addition, the invention as recited in claim 7 further includes “a location registration message generating section coupled to the comparing section for generating a location registration message to attempt a location registration to the mobile switching center when the BTS information is not included in the home-zone list.” As discussed above with regard to the rejection of claim 1, neither Bridges nor Chow, alone or in combination, disclose or suggest the informing step. It follows that these references also fail to disclose or suggest the location registration message generating section of claim 7.

In an apparent attempt to compensate for the shortcomings in the prior art

of record, the Examiner has taken Official Notice:

that the concept of the mobile station passes form one cell to another cell by comparing "predetermined signal" are well known in the art. It would have been obvious the mobile station knows it is out of, or deviates from, BTS cell coverage area by signal strength detection.

Applicant traverses the Official Notice.

The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) MPEP 2144.03.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) MPEP 2143.03

The prior art of record fails to teach or suggest all of the limitations of claim 7, irrespective of whether the purported "well-known" statement can be proved through an evidentiary reference.

Accordingly, claim 7 is believed to be patentable over the prior art of record for at least the foregoing reasons.

As to claim 12, it recites a memory, receiving section and comparing

section analogous to those of claim 7, and is deemed to be patentable for at least the same reasons. Claim 12 has been amended to correct typographical errors. Support for the amendment of claim 12 is found in the specification (page 8, line 18 to page 9, line 2).

Claims 2, 8 and 14 depend from base claims 1, 7 and 12, respectively, and are likewise deemed to be patentable.

Claims 3-6 and 9 were rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of Chow and U.S. Patent No. 5,642,398 to Tiedermann, Jr. et al. ("Tiedermann").

As to claim 3, it recites a method for a mobile switching center that includes the steps of:

“checking whether a location registration request is received from a portable radio telephone;

if the location registration request is received, checking whether the portable radio telephone deviates from the home zone by checking whether the current position of the portable radio telephone is included in a home-zone list . . .”

Item 3 of the Office Action suggests that “modified Bridges” discloses these limitations and then cites Chow as disclosing them in column 8, lines 39-65.

Chow states “Based on the user’s current location information, the network determines

the preferred service profile for the user (col. 8, lines 50-51). Chow does not disclose a location registration request, a home-zone list or checking the list if the request is received. Tiedermann discloses a mobile station registration method, but fails to make up for the deficiencies in Bridges and Chow. Claim 3 is therefore believed to be patentable over the applied prior art for at least this reason.

As to claims 4-6 and 9 they depend from base claims 3 and 7 and are likewise deemed to be patentable for at least this reason.

Claims 10, 13, and 15-16 were rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of Chow, Tiedermann and U.S. Patent No. 6,321,090 to Soliman ("Soliman").

Claim 15 recites a memory, receiving section and comparing section analogous to those of claim 7, and is deemed to distinguish over Bridges and Chow for at least the same reasons.

Soliman discloses a mobile communication system to facilitate hard handoff, but neither Soliman nor Tiedermann can compensate for the deficiencies of Bridges and Chow. Claim 15 is accordingly believed to be patentable over the applied references.

Regarding claims 10, 13 and 16, they depend from base claims 7, 12 and 15, which have been shown to be patentable, and are deemed to be patentable for at least the

same reasons.

Claim 11 was rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of Chow and U.S. Patent No. 6,345,184 to van der Salm et al. ("van der Salm").

Claim 11 depends from claim 7. Van der Salm discloses a system for providing services to a roaming telecommunications user, but cannot make up for the deficiencies in Bridges and Chow. Accordingly, claim 11 is believed to be patentable over the applied references for at least this reason.

Claim 17 was rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of Chow, Soliman and van der Salm.

Claim 17 depends from claim 15, which has been shown to be patentable, and is likewise patentable.

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. The Examiner is invited to contact the undersigned in the event of any perceived outstanding issues so that passage of the case to issue can be effected without the need for a further Office Action.

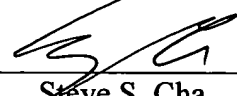
Amendment
Serial No. 09/632,995

Docket No. 5000-1-122.

In the event that any additional fee is required to continue the prosecution of this Application as requested, please charge such fee to Deposit Account No. 502-470.

Respectfully submitted,

CHA & REITER


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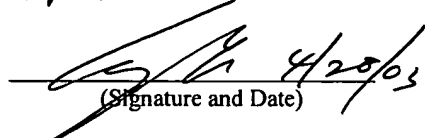
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